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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,777	11/30/2001	Kazuhiko Morita	HOS-62	4620

7590

03/20/2003

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EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/966,777

Applicant(s)

LEE ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 15-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 15-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

1. The species restrictions have been overcome by the present arguments. In the office action, all of the claims are examined together.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 15-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The ranges for X, Y and d set forth in the claims are not accurate representations of what Applicant finds for successfully practicing the invention.

$$5 < X < 40$$

$$100 < d < 300$$

$$\text{then } 145 < 0.29dX < 3480, \text{ since } Y=0.29dX \text{ therefore } 145 < Y < 3480$$

whereas  $100 < Y < 300$  set forth in the claims.

Can Y be anything between 100 and 145?

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao et al (US 5,492,741). Akao teaches a packaging material comprising a polyolefin foam layer 1 having a density of less than 0.5 g/cm<sup>3</sup>, a plurality of polyolefin layers 3a, 7a, 7a', 3a' laminated on at least one side of the polyolefin foam (abstract, figure 3). The outermost and innermost polyolefin layers 3a, 3a' have the same thickness of 25 microns and a melt flow rate of 5.0g/10min, (column 47, lines 46 and 55). The foam density, the thickness of the outermost layer and the melt flow rate disclosed by Akao meet the specific ranges required by the claims. Akao fails to meet the thickness range of the innermost layer. However, since the thickness of the innermost layer is not critical to providing unexpected technical advantages, such a variable would have been recognized by one skilled in the art as dependent upon the intended use of the product. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the innermost layer 3a having a thickness instantly claimed motivated by the desire to improve the adhesion and strength of the laminate since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.
6. Claims 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao et al (US 5,492,741) as applied to claim 1 above, further in view of Sheen et al (6,316,587). Akao discloses the antistatic agent incorporated into the outermost layer of the packaging material in an amount of 0.01 to 10 wt%

(column 42, lines 1-4). Akao does not specially disclose the antistatic agent having a surface resistance less than  $1 \times 10^{13}$  ohm. Sheen discloses a polyamide composition including polyether amide and polyether esteramide having the surface resistance meeting the range required by the claims (column 2, lines 20-25, table 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the polyamide composition as taught in Sheen into the outermost layer of the packaging material motivated by the desire to prevent the build-up of static charges on the surface of the outermost layer.

With regard to claims 17-20, Sheen discloses a synthesis of polyetheramide and polyetheresteramide (column 3, line 21 et seq., column 4, lines 54 et seq). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the synthesis of polyetheramide and polyetheresteramide as taught in Sheen to prepare the antistatic agent because it is a typical and practical method of synthesis of the polyamide composition.

With regard to claims 21 and 22, the amount of the antistatic agent disclosed by Akao overlaps with the values claimed by the present invention.

With regard to claim 23, Since Akao as modified by Sheen is using the same antistatic agent (polyether amide and polyether esteramide disclosed by Sheen) and the same base resin of the outermost layer having a melt flow rate of 5.0 g/10min (Akao, column 47, line 46), it is the examiner's position that the ratio of the melt flow rate would be inherently present. Products of identical chemical

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composition can not have mutually exclusive properties. In re Spada, 15 USPQ 2d 1655 (1990).

With regard to claims 24-26, Akao teaches the laminated foam sheet of closed-cell type having a thickness ranging from 100 microns to 5mm (example 1, column 3, lines 40-45). However, such a variable would have been recognized by one skilled in the art. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ laminated foam having a thickness instantly claimed motivated by the desire to improve the physical strength and cushioning ability of the packaging material since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV  
March 16, 2003

A handwritten signature in black ink, appearing to read "Terrel Morris", with a large, stylized loop at the end.

TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700